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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,673	07/28/2003	William Wayne Cimino	2171CON	7109

7590 07/28/2005

Chief Patent Counsel  
United States Surgical  
a Division of Tyco Healthcare Group LP  
150 Glover Avenue  
Norwalk, CT 06856

EXAMINER
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WILLIAMS, CATHERINE SERKE

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

889

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/628,673	CIMINO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Catherine S. Williams	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/31/03</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-13, 16-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum et al.

Appelbaum discloses a portable base having an upper portion, a display head mounted to the upper portion of the base, an ultrasonic tissue fragmentation device 19, an aspiration system 19, an irrigation system 19, a power system, and a control system. The display head includes flat panel display 5 and touch screen 255. The fragmentation system 19 has a cable with a terminal (module 13). The aspiration and irrigation systems 19 are considered to be coupled to the fragmentation system 19 in light of the fact that multiple microsurgical instruments 19 can be attached with corresponding modules to the console and interact with on another through joint circuits. The modules are attached via pin connectors (connector pattern) to the base 7. The module has programs within the housing (memory). It is considered inherent that the system has a frequency generator since the phacoemulsification power level and phacoemulsification pulse rate can be controlled (14:10+). The system includes a tissue release function and/or laproscopic function in that the surgeon has control using the foot pedal or touch screen (control system) to end (or stop powering) a procedure(s) (i.e. aspiration) at any time while continuing or not continuing other procedures (i.e. fragmentation).

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Appelbaum meets the claim limitations as described above but fails to include the display being adjustable. The courts have held that adjustability where needed is not a patentable advance. In this case, it would have been obvious to make the display adjustable in order for multiple healthcare workers to access the monitor without having to move the device thereby increasing the safety to the patient from inadvertent movement.

Claims 5-6, 14-15 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelbaum et al in view of Andrew et al.

Appelbaum meets the claim limitations as described above but fails to include the irrigation system having a cooling system and a fluid control device.

Andrew discloses an apparatus for liquefaction and aspiration that includes the use of a cooled solution for irrigation. It is considered inherent that the system will also have a fluid control device since the device also has a heated irrigation solution and administration of the two solutions is tightly controlled to prevent undue heating of surrounding tissue.

At the time of the invention it would have been obvious to incorporate the device of Andrew into the invention of Appelbaum in order to provide a system that would provide enhanced safety to the patient.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 571-272-4970. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

A handwritten signature in cursive script that reads "Catherine S. Williams".

Catherine S. Williams

July 22, 2005